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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,587	09/27/2001	Sundar J. Rajan	54676US002	2684
32692	7590	03/29/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY			CHEVALIER, ALICIA ANN	
PO BOX 33427			ART UNIT	
ST. PAUL, MN 55133-3427			PAPER NUMBER	

1772

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/937,587

Applicant(s)

RAJAN ET AL. 

Examiner

Alicia Chevalier

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 25 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1-19.Claim(s) withdrawn from consideration: 20-36.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2/25/04.
10. ☐ Other: \_\_\_\_\_

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Continuation of 5. does NOT place the application in condition for allowance because: It remains the Examiner's position that the claims are unpatentable for reasons previously of record in the final office action.

### **RESPONSE TO AFTER FINAL**

1. Claims 1-36 are pending in the application, claims 20-36 are withdrawn from consideration due to Applicant's previous election.

### ***REJECTIONS MAINTAINED***

2. The 35 U.S.C. §102 rejection of claims 1-3 and 5-19 over Orensteen et al. (US Patent No. 5,508,105) is maintained for reasons previously made of record in paper #6, mailed May 6, 2003, pages 2-4, paragraph #4.

3. The 35 U.S.C. §103 rejection of claim 4 as over Orensteen in view of Frank et al. (US Patent No. 5,153,618) is maintained for reasons previously made of record in paper #6, pages 4-5, paragraph #6.

### ***ANSWERS TO APPLICANT'S ARGUMENTS***

4. Applicant's arguments in the after final response filed February 25, 2004 regarding the 35 U.S.C. 102 and 103 rejections of record have been carefully considered but are deemed unpersuasive.

Applicant argues that the primary reference, Orensteen, fails to teach a radiation cured coating. As Applicant points out the Examiner's position was and still is, that

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example 1 discloses that the different polyurethane compositions may have crosslinkers (col. 16, line 41). Example 1 further discloses that the coating is cured at room temperature followed by heating (col. 17, lines 16-17). Heat is a type of radiation, thus the composition is a radiation cured composition.

Applicant further points to the specification at page 15, lines 11-20 and argues that the Examiner's position that heat is also a type of radiation curing is contrary to the definition set for in the Applicant's application. During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." MPEP § 2111. The part of the specification that Applicant refers to starts out "*more preferred*." This language does not exclusively limit the types of radiations to only those listed in Applicant's specification, because they are merely preferred types of radiations. Giving the limitation "radiation cured coating" its broadest reasonable interpretation in light of the specification is coating that is cured by any type of radiation.

### ***Information Disclosure Statement***

5. The information disclosure statement filed February 25, 2004 has been received and considered but will not be relied upon for prior art.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac

3/19/04



  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
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3/19/04